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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,625	12/27/2003	Kishore R. Shah	KS4	7504

7590

08/31/2006

Nancy A. Bird
231 Walton Ave
South Orange, NJ 07079

EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT PAPER NUMBER

1618

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/748,625		SHAH, KISHORE R.	
	Examiner		Art Unit	
	James W. Rogers, Ph.D.		1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9, 12-15, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20060818</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species: 1) the various uses of the composition.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 9,12-15 and 18-20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

During a telephone conversation with Nancy Bird on 08/21/2006 a provisional election was made with traverse to prosecute the invention of a face make up claim 18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9,12-15 and 19-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant's election of a face make up in the telephonic provisional election on 08/21/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8,10-11,16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrissey et al. (US 6,106,820).

Morrissey teaches cosmetic formulations for use as facial moisturizers, lipsticks and mascaras comprised of 0.1-50% based on weight of the composition of a graft copolymer (could be formed from monomers of acrylic acid, methacrylic acid and styrene), 50-99.9% of a carrier including water or organic solvents, 0.1-10% of thickeners selected from hydroxyethyl cellulose, hydroxypropyl cellulose and xanthan gum and therapeutic agents such as anti-microbials and vitamins. See abstract, col 4 lin 4-lin 47, col 6 lin 16-52, col 12 lin 11-42, col 13 lin 47-67, col 17 lin 33-56 and examples 4-5 and 10-13. The limitations in claim 4 on the form of the composition are met because Morrissey teaches that the compositions can be in the form of a solution, emulsion, cream and lotion. Regarding claim 8 Morrissey discloses that the composition can be applied by a spray or brush. See col 14 lin 49-51 and col 19 lin 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-8,10-11,16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah (US. 5,942,243, cited by applicant).

Shah discloses a mucoadhesive composition for administration of a biological active agent to animal tissue. The composition is comprised of a graft copolymer comprised of polystyrene and at least one acidic monomer(s), the composition further comprises 0-75% of a water-soluble polymer. See abstract, col 2 lin 49-col 3 lin 24, col 5 lin 40-col 6 lin 44 and examples. Regarding the limitation on the weight % of the graft copolymer while the Shah patent is silent on the weight percent of graft copolymer it does disclose that the composition comprises by weight percent a water soluble polymer 0-75 % and 0.01-40% of active drug, it is obvious from the combined weight percents above that the graft copolymer could be within applicants specified weight percentage therefore the limitation is met. Regarding claim 11, Shah discloses that water is an ingredient in the drug delivery vehicle, thus meeting the limitation of an aqueous formulation. See col 10 lin 57-64. Regarding claim 10, while Shah is silent on the specific method for applying the composition other than using the hand or other suitable applicator, it would have been obvious that the composition could be applied by

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a spray, immersion, brush ect. because they are all obvious suitable applicators for a topical application.

Claims 1-8,10-11,16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah (US. 5,942,243, cited by applicant) in view of Morrissey et al. (US 6,106,820).

Shah is disclosed above. Shah does not disclose the use of the composition as a face make up and the specific applicator for applying the topical composition.

Morrissey is disclosed above. Morrissey is used to primarily show that compositions comprised of graft copolymers, hydrophilic polymers (used as thickeners) and therapeutic agents for use in facial cosmetics and applying the topical composition with a spray or brush were well known at the time of the invention.

It would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to combine the art described in the documents above because Shah discloses the same composition as applicants claimed invention except for its use in facial cosmetics and the method to apply the composition while Morrissey is used to show that compositions comprised of graft copolymers and hydrophilic polymers for use in facial compositions and applying the composition by spray and brush were well known in the art at the time of the invention. The motivation to combine the above documents would be facial composition comprised of graft copolymers, hydrophilic polymers (used as thickeners) and bioactive agents and the method to apply the composition to the skin for providing increased skin retentivity of cosmetic

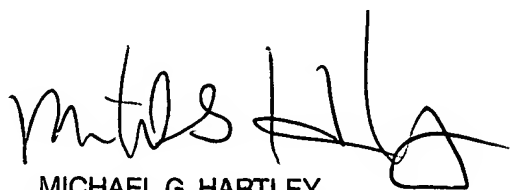
ingredients. Thus, the claimed invention, taken as a whole was *prima facie* obvious over the combined teachings of the prior art.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER